



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/526,257	02/28/2005	Vincent Moreau	1204.1110101	7062

7590 07/11/2008
David M Crompton
Crompton Seager & Tufte
1221 Nicollet Avenue
Suite 800
Minneapolis, MN 55403-2420

EXAMINER

GRABOWSKI, KYLE ROBERT

ART UNIT	PAPER NUMBER
----------	--------------

3725

MAIL DATE	DELIVERY MODE
-----------	---------------

07/11/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/526,257	Applicant(s) MOREAU, VINCENT	
	Examiner Kyle Grabowski	Art Unit 3725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>03/31/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4, 6, 10, and 12-13, are rejected under 35 U.S.C. 102(b) as being anticipated by Herrmann et al. (US 2002/0030360).

In respect to claims 1-4 and 6, Herrmann et al. disclose: a value-bearing document 1 comprising a paper substrate 2 with a zone of reduced substrate thickness - depression 8 and window opening 4; a strip of cover foil 5, reinforcing means, which "adheres firmly to the surface 6 of the carrier 2 around the opening 4 in the regions 7" (0032, Fig. 2) covering the zone of reduced thickness, 4 and 8, on the top of the paper substrate 2; the cover foil 5 comprising a carrier film 15 which also covers the zone of reduced thickness, 4 and 8; the carrier film 15 is "perfectly transparent" and made of polyester or polycarbonate (0054, Fig. 2); the cover foil 5 comprises an additional security feature 13 (0037, Fig. 1).

In respect to claims 10 and 12-13, Herrmann et al. inherently disclose the claimed subject matter for the reasons stated above including a process of producing a

Art Unit: 3725

banknote with a zone of reduced thickness forming a window and covering the zone with reinforcing means (a strip or patch of material) and further including an additional security feature. The end product disclosed in Herrmann et al. inherently discloses these steps.

3. Claims 1, 3, 5, 7, 8, 10, and 11, are rejected under 35 U.S.C. 102(e) as being anticipated by Keller et al. (US 2005/0104364).

In respect to claims 1, 3, 5, 7, and 8, Keller et al. disclose: a security substrate paper 1, with a zone of reduced substrate thickness - depression 5 and window opening 2; a strip of material, security element 3, covers and reinforces the zone of reduced thickness (Fig. 2); the security element 3, also a 'patch' which covers and reinforces the zone of reduced thickness, comprises an optically variable element (Abstract) which utilizes an similar layers 6 and 7 that include metal layers 12 and 13 with interruptions 16 and 18, caused by "laser removal, etching or washing" (0047, Fig. 3); Figure 13 shows that two security elements 27 and 28, corresponding to the elements 6 and 7 (0068) of to the aforementioned security element 3, can be placed on both sides of the paper substrate 1. In respect to claim 8, the security elements 27 and 28 are broadly both a "strip" and a "patch" and therefore Figure 13 discloses all of the claimed subject matter for the reasons stated above.

In respect to claims 10 and 11, Keller et al. inherently disclose the claimed subject matter for the reasons stated above including: a process of producing a

Art Unit: 3725

banknote with a zone of reduced thickness forming a window and covering the zone with reinforcing means (a strip or patch of material) on each side of the security substrate. The end product disclosed in Keller et al. inherently discloses these steps.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Herrmann et al. (US 2002/0030360) in view of the application's admission of prior art. Herrmann does not disclose a sheet comprising a plurality of value-bearing documents (notes) however the applicant discloses "a plurality of notes placed in successive rows and columns, as it is done in a *known fashion* for banknotes" (Pg. 7, Para 4). It would have

Art Unit: 3725

been obvious to one of ordinary skill in the art at the time of the invention was made to provide the value-bearing documents taught in Herrmann et al. in a multiple array in view of the disclosure in the present application of admitted prior art to incorporate the security features economically onto one single sheet to be later cut into individual notes.

7. Claims 1, 10, 14, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goguelin et al. (US 6,630,055) in view of Hermann et al. (US 2002/0030360). Goguelin disclose a method of manufacturing a coated paper, the coated paper characterized by one or more zones comprising a reduction in thickness relative to the remainder of the coated paper (Abstract); one process of reducing thickness in the zones results in "pseudo-watermarks" which are characterized by a permanent transparency present in the paper fibers (therefore not a through hole), creating transparent windows on the said zones (Col. 2, 1-9). Goguelin does not disclose providing reinforcing means to increase the resistance of the zone of reduced thickness however Hermann et al. discloses providing a reinforcing means, cover foil 5, which adheres firmly around a zone of reduced thickness opening 4 (0032, Fig. 2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the zone of reduced thickness (pseudo-watermarks resulting in zones of transparency) taught in Goguelin with a cover foil in view of Herman et al. to afford a paper with reduced thickness with stability. Hermann et al. describes that the presence of such a cover foil even provides stability in the more extreme example of through openings (0013)

Response to Arguments

Applicant's arguments filed 03/31/08 have been fully considered but they are not persuasive.

In re claims 1-4, 6, 10, and 12-13 as rejected by Hermann et al. the applicant's representative claims that "the depression (8) does not form a transparent window" however the office action claims that the depression (8) *and* opening (4), *together*, comprise a zone that forms a transparent window (see above). The applicant also argues that "one of skill in the art, having read and understood the instant application, will appreciate that a zone of reduced substrate thickness is a zone in which the thickness of the substrate has been reduced" and the examiner agrees. The examiner also contends that a substrate of zero thickness (the zone of the window and opening) *is* a reduction in thickness (i.e. from any positive number to zero) as defined broadly by the claims.

In re claims 1, 3, 5, 7, 8, 10, and 11 as rejected by Keller et al. the applicant's representative makes a similar argument that "a zone of reduced substrate thickness is not a hole or opening through the substrate" and the examiner again contends that zero thickness (window opening).

In re claim 9, as rejected over Hermann in view of applicant's admission of prior art. The applicant contends that this claim is allowed based only on the arguments above which have the examiner has disagreed.

Claims 14 and 15 are rejected for the reasons state above.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyle Grabowski whose telephone number is (571)270-3518. The examiner can normally be reached on Monday-Thursday, every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (571)272-4419. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3725

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kyle Grabowski/
Examiner, Art Unit 3725